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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/652,899	08/31/2000	Fred Alan Bishop	10655.8000	3558

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EXAMINER	
WORJLOH, JALATEE	
ART UNIT	PAPER NUMBER
3621	

DATE MAILED: 05/09/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	09/652,899	BISHOP ET AL.	
	Examiner	Art Unit	
	Jalatee Worjloh	3621	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *18 April 2006*.

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-4,43-46 and 90-103* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-4,43-46 and 90-103* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

DETAILED ACTION

Response to Amendment

1. This Office Action is responsive to the amendment filed April 18, 2006, in which claims 1,4, 43, 90, 96, 98,99 and 101 were amended.

Response to Arguments

2. Applicants' arguments filed April 18, 2006 have been fully considered but they are not persuasive.

Applicants' argue, "Kausik et al. fails to teach or disclose the use of an intelligent token utilized to conduct a secure electronic transaction" and that Kausik et al. "teaches conducting electronic transactions without utilizing verifiable hardware". However, the examiner notes that Kausik et al. teach using physical tokens with the present invention. That is, Kausik et al. indicate, "the present invention could as be used in conjunction with a physical token, as desired" (see col. 4, lines 45-47). Therefore, Kausik et al. teach the features of Applicants' invention including "issuing a challenge to the user, wherein said challenge is passed to an intelligent token for processing said challenge, wherein said intelligent token generates a response to said challenge".

Claim Rejections - 35 USC § 102

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

4. Claims 1-3, 43-45 and 90 are rejected under 35 U.S.C. 102(e) as being anticipated by U.S. Patent No. 6263446 to Kausik et al.

Referring to claim 1, Kausik et al. disclose receiving at a first server (i.e. credential server), a transaction request from a user for a transaction at a merchant server (see claim 30(a) – receiving from a requestor, over a network a request for a predetermined authentication credential), issuing a challenge to the user, wherein said challenge is passed to an intelligent token for processing said challenge, (see claim 30 (b) – transmitting, to said requestor, a challenge; claim 34 – said transmitting is to a digital wallet of said requestor; col. 4, lines 35-46 – the wallet could be installed onto the hard drive or other physical memory of the computer ... the invention could also be used in conjunction with a physical token), wherein said intelligent token (i.e. physical token) generates a response to said challenge, receiving said response from the user based upon said challenge (see claim 30 (c) – receiving an answer to said challenge), processing said response to verify the intelligent token (see claim 30 (d) – determining that said answer satisfies said challenge ; claim 34 and col. 4-lines 35-46 – physical token), providing at least a portion of said assembled credentials to said user (see claim 30 (e) transmitting said authentication credential for said requestor and claim 32 – said credential is a private key), receiving, at a second server (i.e. access control server), a second request from said user, said second request including said portion of said assembled credentials provided to said user, and validating at said second server, said portion of said assembled credentials provided to said user with said key of said assembled credentials to provide access to a transaction service (see col. 3,

lines 43-49 & 61-63). As for assembling credentials for the transaction at said first server, said credentials comprising at least one key, this is an inherent step. Notice, Kausik et al. the authentication credential is in existence at said server prior to the request (see claim 30, (a) (i)), which implies that the credential has been created. Claim 32 discloses a credential that is a private key.

Referring to claims 2 and 44, Kausik et al. disclose the transaction is an electronic purchase transaction (see col. 3, lines 22-24).

Referring to claims 3 and 45, Kausik et al. disclose the electronic purchase transaction is conducted using a digital wallet (see claim 34).

Referring to claim 43, Kausik et al. disclose receiving, at a first server (i.e. credential server), a transaction request from a user for a transaction at a merchant server (see claim 30(a) – receiving from a requestor, over a network a request for a predetermined authentication credential), issuing a challenge to the user, wherein said challenge is passed to an intelligent token (i.e. physical token) for processing said challenge, (see claim 30 (b) – transmitting, to said requestor, a challenge; claim 34 – said transmitting is to a digital wallet of said requestor; col. 4, lines 35-46 – the wallet could be installed onto the hard drive or other physical memory of the computer ... the invention could also be used in conjunction with a physical token), wherein said intelligent token generates a response to said challenge, receiving said response from the user based upon said challenge (see claim 30 (c) – receiving an answer to said challenge), processing said response to verify the intelligent token (see claim 30 (d) – determining that said answer satisfies said challenge ; claim 34 and col. 4-lines 35-46 – physical token), providing at least a portion of said assembled credentials to said user (see claim 30 (e) transmitting said

authentication credential for said requestor and claim 32 – said credential is a private key), receiving, at a second server (i.e. access control server), a second request from said user, said second request including said portion of said assembled credentials provided to said user, and validating at said second server, said portion of said assembled credentials provided to said user with said key of said assembled credentials to provide access to a transaction service (see col. 3, lines 43-49 & 61-63). As for assembling credentials for the transaction at said first server, said credentials comprising at least one key, this is an inherent step. Notice, Kausik et al. the authentication credential is in existence at said server prior to the request (see claim 30, (a) (i)), which implies that the credential has been created. Claim 32 discloses a credential that is a private key.

Referring to claim 90, Kausik et al. disclose receiving at a first server (i.e. credential server), a transaction request from a user for a transaction at a merchant server (see claim 30(a) – receiving from a requestor, over a network a request for a predetermined authentication credential), issuing a challenge to the user, wherein said challenge is passed to an intelligent token (i.e. physical token) for processing said challenge, (see claim 30 (b) – transmitting, to said requestor, a challenge; claim 34 – said transmitting is to a digital wallet of said requestor; col. 4, lines 35-46 – the wallet could be installed onto the hard drive or other physical memory of the computer ... the invention could also be used in conjunction with a physical token), wherein said intelligent token generates a response to said challenge, receiving a response from the user based upon said challenge (see claim 30 (c) – receiving an answer to said challenge), processing said response to verify the intelligent token (see claim 30 (d) – determining that said answer satisfies said challenge ; claim 34 and col. 4-lines 35-46 – physical token), providing at least a portion of

said assembled credentials to said user (see claim 30 (e) transmitting said authentication credential for said requestor and claim 32 – said credential is a private key), receiving, at a second server (i.e. access control server), a second request from said user indicating readiness to complete the transaction, said second request including said portion of said assembled credentials provided to said user, and validating at said second server, said portion of said assembled credentials provided to said user with said key of said assembled credentials to thereby permit processing and completion of said transaction (see col. 3, lines 43-49 & 61-63). As for assembling credentials for the transaction at said first server, said credentials comprising at least one key, this is an inherent step. Notice, Kausik et al. the authentication credential is in existence at said server prior to the request (see claim 30, (a) (i)), which implies that the credential has been created. Claim 32 discloses a credential that is a private key.

Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

6. Claims 4, 46 and 91-103 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kausik et al. as applied to claims 1 and 90 above, and further in view of U.S. Patent No. 6873974 to Schutzer.

Referring to claims 4, 96 and 101, Kausik et al. disclose an intelligent token (see claim 1 above – "physical token"). Kausik et al. do not expressly disclose the intelligent token is a smart

card. Schutzer discloses the intelligent token is a smart card (see col. 9, lines 16-24). At the time the invention was made, it would have been obvious to a person of ordinary skill in the art to modify the method disclose by Kausik et al. to include an intelligent token that is a smart card. One of ordinary skill in the art would have been motivated to do this because smart cards are more secure than software wallets and they can be conveniently carried as the user roams (see Kausik et al. col. 1, lines 56-58).

Referring to claim 46, Kausik et al. disclose a user conducts a transaction via a wallet (see claim 43 above). Kausik et al. do not expressly disclose the user conducts the transaction via a smart card. Schutzer discloses the user conducts the transaction via a smart card (see col. 9, liens 16-24). At the time the invention was made, it would have been obvious to a person of ordinary skill in the art to modify the method disclose by Kausik et al. to include the step wherein the user conducts the transaction via a smart card. One of ordinary skill in the art would have been motivated to do this because smart cards are more secure than software wallets and they can be conveniently carried as the user roams (see Kausik et al. col. 1, liens 56-58).

Referring to claim 91, Kausik et al. disclose a user, and second server (see claim 90 above). Kausik et al. do not expressly disclose accessing required information associated with said user from said second server, populating one or more corresponding user purchase forms at said second server with said required information and said second server providing said populated user purchase forms and an authorization response message to a merchant for processing and completion of said transaction. Schutzer discloses accessing required information associated with said user from said second server, populating one or more corresponding user purchase forms at said second server with said required information and said

second server providing said populated user purchase forms and an authorization response message to a merchant for processing and completion of said transaction (see col. 2, lines 15-27). At the time the invention was made, it would have been obvious to a person of ordinary skill in the art to modify the method disclose by Kausik et al. to include the steps of accessing required information associated with said user from said second server, populating one or more corresponding user purchase forms at said second server with said required information and said second server providing said populated user purchase forms and an authorization response message to a merchant for processing and completion of said transaction. One of ordinary skill in the art would have been motivated to do this because it provides an electronic system that allows users to easily interact with merchants.

Referring to claims 92, 93, 100 and 102, Kausik et al. disclose the transaction is an electronic purchase transaction and the transaction is a web-based purchase transaction (see col. 3, lines 22-24).

Referring to claims 94 and 95, Kausik et al. disclose the electronic purchase transaction is conducted using a digital wallet (see claim 34).

Referring to claims 97 and 103, Kausik et al. disclose an electronic transaction system (see claim 91 above). Kausik et al. do not expressly disclose said required information includes user name, user address, shipping address, card number and payment amount. Schutzer disclose said required information includes user name, user address, shipping address, card number and payment amount (see abstract). At the time the invention was made, it would have been obvious to a person of ordinary skill in the art to modify the method disclose by Kausik to include said required information includes user name, user address, shipping address, card number and

payment amount. One of ordinary skill in the art would have been motivated to do this because it provides an electronic system that allows users to easily interact with merchants.

Referring to claim 98, Kausik et al. disclose receiving at a first server (i.e. credential server), a transaction request from a user for a transaction at a merchant server (see claim 30(a) – receiving from a requestor, over a network a request for a predetermined authentication credential), issuing a challenge to the user, wherein said challenge is passed to an intelligent token (i.e. physical token) for processing said challenge, (see claim 30 (b) – transmitting, to said requestor, a challenge; claim 34 – said transmitting is to a digital wallet of said requestor; col. 4, lines 35-46 – the wallet could be installed onto the hard drive or other physical memory of the computer ... the invention could also be used in conjunction with a physical token), wherein said intelligent token generates a response to said challenge, receiving a response from the user based upon said challenge (see claim 30 (c) – receiving an answer to said challenge), processing said response to verify the intelligent token (see claim 30 (d) – determining that said answer satisfies said challenge ; claim 34 and col. 4-lines 35-46 – physical token), providing at least a portion of said assembled credentials to said user (see claim 30 (e) transmitting said authentication credential for said requestor and claim 32 – said credential is a private key), receiving, at a second server (i.e. access control server), a second request from said user, said second request including said portion of said assembled credentials provided to said user, and validating at said second server, said portion of said assembled credentials provided to said user with said key of said assembled credentials to thereby permit processing and completion of said transaction (see col. 3, lines 43-49 & 61-63). As for assembling credentials for the transaction at said first server, said credentials comprising at least one key, this is an inherent step. Notice, Kausik et al. the

authentication credential is in existence at said server prior to the request (see claim 30, (a) (i)), which implies that the credential has been created. Claim 32 discloses a credential that is a private key. Kausik et al. do not expressly disclose accessing required information associated with said user from said second server, populating, at said second server, one or more corresponding user purchase forms with said required information and said second server providing said populated user purchase forms and an authorization response message to a merchant for processing and completing said purchase transaction. Schutzer discloses accessing required information associated with said user from said second server, populating one or more corresponding user purchase forms at said second server with said required information and said second server providing said populated user purchase forms and an authorization response message to a merchant for processing and completion of said transaction (see col. 2, lines 15-27). At the time the invention was made, it would have been obvious to a person of ordinary skill in the art to modify the method disclose by Kausik et al. to include the steps of accessing required information associated with said user from said second server, populating one or more corresponding user purchase forms at said second server with said required information and said second server providing said populated user purchase forms and an authorization response message to a merchant for processing and completion of said transaction. One of ordinary skill in the art would have been motivated to do this because it provides an electronic system that allows users to easily interact with merchants.

Referring to claim 99, Kausik et al. disclose receiving said challenge at said intelligent token (see claim 30 (b) and claim 34 – transmitting, to said requestor, a challenge...said transmitting is to a digital wallet of a requestor), receiving said personal identifier (i.e. PIN) from

said user, said instrument validating said personal identifier sand unlocking said instrument (see col. 5, lines 10- 24, the user enters a PIN to unlock the wallet...the PIN is compared with a stored hash value...if the two hash values agree, the PIN is passed to decryption module...the decrypted private key is released for use), said intelligent token transmitting said response to said first server (see claim 30 (c)). As for the step of said intelligent token prompting said user for a personal identifier this is an inherent step. That is, before the user enters the PIN, he must have previously been prompted for such entry.

Conclusion

7. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jalatee Worjloh whose telephone number is (571) 272-6714. The examiner can normally be reached on Mondays-Thursdays 8:30 - 7:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James Trammell can be reached on (571) 272-6712. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300 for Regular/After Final Actions and 571-273-6714 for Non-Official/Draft.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Any response to this action should be mailed to:

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P.O. Box 1450
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Jalatee Worjloh
Patent Examiner
Art Unit 3621

May 1, 2006

PRIMARY EXAMINER